

Remarks

This is a full response to the outstanding non-final office action mailed August 22, 2006. The office action noted various objections and informalities that will be addressed here.

The office action objected to the abstract. The abstract has now been amended to include a description of an exemplary embodiment. Reconsideration of the objection in light of the amended abstract is hereby requested.

In response to the request made in the office action, Applicants have amended the citation information in the first paragraph of the specification.

The declaration was objected to as being defective for failure to include the date by one of the inventors' signatures. A substitute declaration is included with this response.

Claim Amendments

Claims 1, 4-6, 10-12, and 14 have been amended. Claim 9 has been canceled. Basis for the amendment of claim 1 may be found in original claim 9 and on page 17 (top) and elsewhere in the specification. Basis for the amendment of claims 4-6 may be found in original claim 2 and on pages 19-20 and elsewhere in the specification. Claims 10-12 have been amended to correct dependencies. Claim 14 has been amended to render it consistent with amended claim 1; basis may be found in original claim 14, in the specification at pp. 15-17, and elsewhere in the specification. No new matter has been included by the current amendments. Applicants make these amendments while reserving all subject matter and without prejudice to Applicant's right to pursue such subject matter in one or more continuation, divisional, or continuation-in-part applications.

Rejections under 35 USC §112, first paragraph:

Claims 1-23 were rejected under 35 USC §112, first paragraph, as allegedly not being of commensurate scope with the subject matter enabled in the specification. Claims 1-23 have now been amended to reduce the overall scope of the claimed

subject matter by requiring that the reactive phosphorus group have the structure (VI) (as set forth in the listing of claims, above). It is submitted that the claims as amended are of reasonable scope given the descriptions in the specification and the level of skill in the art. Reconsideration of the claims is respectfully requested.

Claim 14 was objected to because of informalities regarding capitalization. The amendment of claim 14 has removed the noted capitalization error and reconsideration of the amended claim is respectfully requested.

Rejections under 35 USC §112, second paragraph:

Claims 1-35 were rejected under 35 USC §112, second paragraph, as allegedly being indefinite.

As noted, Applicants have amended claim 1, thus providing additional structure to the claims. Applicants have also amended claims 4-6 to include the proviso clause, as mentioned by the Examiner. Applicants note that this amendment is made without acquiescing to the Examiner's argument that "no 'reactive phosphorus group' attachment is permitted or provided for in any one of claims 4-6". Applicants request the careful reconsideration of claims 3-6 on this point.

Claim 13 recites "contacting a solid support having an available reactive group bound thereto with a reagent according to claim 1, the contacting being performed under conditions and for a time sufficient to result in the nucleoside moiety bound to the support via the triaryl methyl linker group, wherein the triaryl methyl linker group is bound to the support via a phosphorus-containing linkage group." To briefly paraphrase the claim, Claim 13 thus positively recites a method that includes contacting the solid support . . . with the reagent . . . to result in the nucleoside moiety bound to the support . . . This is very much a proper process claim – it recites contacting said materials under appropriate conditions to provide a defined result. And, with the present amendments to claim 1, the claim now positively recites structure that was not in original claim 1. Reconsideration of the claim in light of this discussion and the amendments is respectfully requested.

Claims 1 and 13 were objected to as not completely described. Applicants traverse this rejection to the extent it still applies to the amended claims. The insistence on a discrete chemical structure is unreasonable in light of the standard of

definiteness. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). The test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Under the present claims, anyone reading the claim is given effective notice in claim 1 that a reagent having the structure “ Phos—Cgp—Trl—Cgp’—Nucl ” is the subject of the claim. That structure is further limited by the remaining portion of claim 1, and also elements recited in the remaining claims. And, this definition of subject matter is further described with reference to the specification. For example, the reader will be able to determine whether the Phos group, as further defined in claim 1 and described in the specification, is present in the subject matter the reader is concerned with. The reader will also be able to discern whether the Phos group is attached to a triaryl methyl linker group via a connecting group as set out in the claim. The reader will also be able to discern whether there is a nucleoside moiety attached, and so on. Thus, the terms appear to be sufficiently definite to put a potential infringer on effective notice, or, on the other hand, to allow a person to design-around the subject matter of the claims by being able to ascertain the boundaries of the claim with reasonable certitude. Reconsideration of the claim in light of this discussion is respectfully requested.

The office action rejected claim 2, stating that “the term ‘substituted aryl’ is incomplete because the substituents implied thereby have not been defined.” A list of other claims were likewise noted to have similar errors. The office action in this regard appears to have not stated a case – why is it deemed necessary to state the implied substituents in the claims? The specification at the bottom of page 10 describes substituted aryl groups. The specification at page 14 describes substitution

and substituents. Thus, a claim, such as claim 2, that recites “selected from unsubstituted or substituted aryl groups” reads on for example, embodiments in which the noted aryl groups are substituted and also on embodiments in which the noted aryl groups are not substituted. Thus, since a reader (possible infringer, person designing around, other person) will be able to readily discern whether a given compound has an aryl group as recited in the claim and, for example, further has (or does not have) a substituent on the aryl group, then the reader will be reasonably informed as to whether the claim is infringed or not for the given compound. The argument applies *mutatis mutandis* to the method claims of claims 13 *et seq.* Thus, the terms appear to be sufficiently definite to allow the reader to ascertain the boundaries of the claim with reasonable certitude. Reconsideration of the claim in light of this discussion is respectfully requested.

Claims 18 and 19 were rejected as “directed to subject matter not relevant to the subject matter of claims 1 and 13 and thereby lack proper antecedent basis”. A brief reference to the claims reveals that claim 13 states

“A method comprising:
contacting a solid support [etc.] ”

Claim 18 states

“The method of claim 17, further comprising
contacting the nucleoside moiety [etc.] ”

And claim 19 states

“The method of claim 18, wherein the combined [etc.] ”

To fill in the missing link, claim 17 states

“The method of claim 13, wherein the nucleoside moiety [etc.] ”

Thus, claims 18 and 19 depend from claim 13 via claim 17. There are no twists or nor convoluted constructions. Claim 18 recites a method that incorporates the subject matter of claims 17 and 13 and requires the additional elements of recited in claim 18. Likewise for claim 19. The office action fails to point to any valid

antecedent basis problem in claims 18 and 19. Reconsideration of the claim in light of this discussion is respectfully requested.

The office action further stated that claim 20 included the term “the bond via which the reactive nucleoside group is attached to the nucleoside moiety” and raises an antecedent basis question. However, this appears to be a misquote of claim 20. Claim 20 recites “the bond via which the triaryl methyl linker group is bound to the nucleoside moiety”. Reconsideration of the claim in light of this discussion is respectfully requested.

Applicants now request reconsideration and allowance of all the claims, as amended, in light of the discussion herein. If any further issues arise in this case that may be resolved via a telephone call, the person responsible for this case is invited to call the applicant’s attorney at the phone number given below.

Agilent Technologies, Inc.
Intellectual Property Admin., M/S DL429
P.O. Box 7599
Loveland, CO 80537-0599

Respectfully submitted,



By: Michael J. Beck
Reg. No. 40907
Phone (408) 553-3864

Enc: declaration